

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: Robertson, S.
Serial No.: 10/634,627
Title of Invention: System and Method for Providing Electronic Multi-Merchant
Gift Registry Services Over a Distributed Network
Filing Date: 08/05/2003
Group Art Unit: 3625
Examiner: Rosen, N.
Attorney Docket No.: ROBERT.P002D1

Seattle, Washington 98109
January 28, 2008

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REPLY TO EXAMINER'S ANSWER

Applicant responds to the Examiner's Answer dated 11/28/2007 as follows:


The Examiner has added no new arguments to his rejections of the claims in the "Grounds of Rejection" section (9) of the Examiner's Answer, but repeats the rejections of his final action dated 1/31/2007 verbatim. Therefore no reply is deemed necessary to that portion of his Answer.

The Examiner begins the "Response to Argument" section (10) by stating, "The primary question is whether the Examiner's taking of official notice was proper and permissible..." This is just not true. The primary question on this appeal remains whether the Cohen reference, combined with "official notice," does in fact anticipate each and every element of limitations in the rejected claims. Appellant believes that it is clear that the Cohen reference does not teach each and every limitation of the claims, not even of the independent claims, and whether or not any

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January 28, 2008


Patrick Dwyer

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official notice was properly taken. Proper use of official notice is an issue, but not the “primary question”.

Numerous limiting elements in the claims are just not taught by any prior art cited by the Examiner and these untaught elements are of such a character that they cannot be considered obvious, or well known, facts; that is, they are manifestly not “capable of instant and unquestionable demonstration” as is required both by case law and by Section 2144.03(A) of the MPEP in order for official notice to be taken at all.

Independent claims 29 and 47 require, under proper and legal interpretation of claim elements, much more than just running a gift registrar application on at least one gift registry site, though the Examiner continues to treat this case as if this is the only limitation he must find in the prior art. For instance, the claims in fact also require both (1) and (2) below.

1) “...a gift registrant accessing goods or services online from a plurality of goods or service provider sites...” Note the plural in “sites;” not just a site, but a plurality of sites. Not just one gift registry web site where a third party has posted a list of items to be bought, but actual access to a plurality of web sites maintained by the goods or service providers themselves, and to which the gift registrant herself goes via online access. For example, registrant accesses, not a list somewhere of what Nordstrom’s might be offering, but goes online herself to Nordstrom’s actual web site (and for Claim 29, at least one other merchant site). The three web sites reported by Cohen merely list goods or services that are supposedly sold elsewhere by other goods and service providers who themselves have no connection to any of the three sites reported by Cohen.

2) “...a gift registrant...registering a gift selection from each of the plurality of SP sites...” A further limitation is that the gift registrant has to register the gift selection from (i.e. while shopping on) the plurality of goods or service provider web sites. The gift registrants access a plurality of goods or provider web sites and at each of the plurality of sites they register their gift selection. This is not taught by Cohen. Each of the three web sites reported by Cohen require that gift registrants either: a) select their gifts from a list posted on the one registry (list only) web site, or b) peruse merchant’s sites and then return to the gift registry site “to supply the site with

ordering information” (Cohen, Paragraph 4, Line 21) for the gifts they wish to list. Both methods are completely different from Appellant’s claimed limitations.

All of these limitations as described above are well supported in Appellant’s application specification. And none of these limitations, found in independent claims 29 and 47, is taught by Cohen; nor does the Examiner in any of his response point out with any particularity just where in Cohen these two other limitations (at least two), are to be found.¹

Independent claim 46 does not require a plurality of goods and service provider sites as does claim 29; instead it only requires access to one goods and service provider. Much of the argument above still applies to Claim 46 however. The site accessed by the gift registrant is still owned and run by the particular goods or service provider itself and the gift registrant still has to register a gift selection while shopping on that goods or service provider web site.

The Examiner has stated on pages 19 and 21 of his Answer that he cannot “imagine how else (without a computer application) such sites [the web sites briefly described in the Cohen article] must operate.” Appellant again states that it is not just any application, but an application that enables all the claimed limitations that must be found by the Examiner and taught by the cited art in order to meet the limitations of the claims. The Examiner points out on page 21 of his Answer that Appellant “gives no example” of how the web pages reported by Cohen could have been published without Appellant’s application elements. It is not Appellant’s job to join the Examiner in speculating how someone could have created the web pages briefly described by Cohen without the specific claim elements of Appellant’s gift registry application. But, since it has been implied that any failure to do so will admit to there being no such method, Appellant offers that it would have been simple at the time to do so, without practicing the subject matter of the claims.

The following example method conforms to all the elements reported by Cohen. A Wedding Channel employee sits with a stack of gift catalogs at their elbow and types into an HTML document the names of individual gifts between an HTML list tag. (If there are multiple

¹ The Examiner only ever just baldly asserts that Cohen “meets all the limitations”.

web pages, showing different product features or departments, they enter gift names into multiple HTML documents, one for each page to be displayed on the web site.) Each gift's name is also displayed with a checkbox using an HTML checkbox tag. The HTML document displays the list on the Wedding Channel's web site. A gift registrant types their name into a text box and selects items by viewing the web page and clicking the checkbox next to the displayed gift on the list, finally clicking a submit button. A CGI script receives the query_string variables and checkbox value variables using the GET method and creates a text document that can be viewed by the Wedding Channel employee in a text display. Note that the submitted gift selections are never stored in a database, or any data structure. They are merely transferred as text from an HTML document to another text document. The Wedding Channel employee then reads the text document and creates a new HTML document to display that registrant's gift selections with accompanying check boxes when the page is navigated to by a gift purchaser. The checkbox process is repeated by the gift purchaser and the resulting text document is viewed by a Wedding Channel employee who calls the gift vendor on the phone and orders the gift.

The previous example was presented for illustrative purposes only, and is believed to be not the only such possible example that does not practice the subject matter of the claims on appeal. The attention of the Board is respectfully directed to the facts that, in this example method, 1) the gift registrant does not access a plurality of goods or services provider's sites, 2) the site accessed is certainly not the goods or services provider's web site, the only site accessed is a third party's site-Wedding Channel's site, 3) the gift registrant cannot register a gift while browsing the goods or services provider's site and 4) the gift list is not stored in a data structure, such as a database. And yet, this simple method was capable in 1999 of fulfilling the sparse disclosures reported in Cohen.

Appellant also must point out that as early as in the 1st OA reply filed December 20, 2006 (page 10), and in every filing since that time, Appellant has pointed out that the web sites described by Cohen are so lacking in any technical detail that they might be nothing more than hand created HTML documents displaying lists.

In the Examiner's Answer, the Examiner implies that Appellant is attempting to ignore or obscure MPEP directives for proper use of official notice, notice that, "where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known" (Examiner's Answer, Page 17, Paragraphs 2-3). Appellant assures the Board that this is not the case; the Board will note that Appellant quoted the above phrase numerous times in the Appeal Brief. It is just Appellant's point, and the truth is, the facts in this case are not "capable of instant and unquestionable demonstration as being well-known".

In the *Fox* cases, cited by the MPEP and by the Examiner, all that happened was that "judicial notice" was taken of the fact that tape recorders commonly erase tape automatically when new "audio information" is recorded on a tape which already has a recording on it. Hardly the kind of sweeping notice taken by the Examiner in this case.

In *Zurko*, all that was held was that trusted path communications are not common knowledge - that is, the PTO was actually reversed for misuse of official notice!

Finally, the deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is "basic knowledge" or "common sense" to one of ordinary skill in the art. As described above, the Board contended that even if the cited UNIX and FILER2 references did not disclose a trusted path, "it is basic knowledge that communication in trusted environments is performed over trusted paths" and, moreover, verifying the trusted command in UNIX over a trusted path is "nothing more than good common sense." *Ex parte Zurko*, slip op. at 8. We cannot accept these findings by the Board. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. [emphasis added] As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. [emphasis added] Rather, the Board must point to some concrete evidence in the record in support of these findings. To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise. *Baltimore & Ohio R.R. Co. v. Aberdeen & Rockfish R.R. Co.*, 393 U.S. 87, 91-92, 21 L. Ed. 2d 219, 89 S. Ct. 280 (1968) (rejecting a determination of the Interstate Commerce Commission with no support in the record, noting that if the Court were to conclude otherwise "the requirement for administrative decisions based on substantial evidence and reasoned findings -- which alone make effective judicial review possible -- would become lost in the haze of so-called expertise" [emphasis added]). Accordingly, we cannot accept the Board's unsupported assessment of the prior art.

Next the Examiner claims that Appellant did not traverse the examiner's taking of official notice and that the traversal of the Examiner's taking of official notice is untimely. This is blatantly not true. Following are quotes from the Remarks section of Appellant's Amendment and Response to the Examiner's Office Action filed 12/20/2006:

"Claims 29, 30 and 32 are rejected under 35 U.S.C. 103 (a) as allegedly unpatentable over the article "Going to the Chapel" by Cohen in view of official notice; Applicant respectfully traverses this rejection. The Examiner admits that Cohen does not expressly disclose element (a) of base Claim 29, "running a gift registrar application on at least one gift registry site". The Examiner then asserts an unsupported 'official notice' that "running applications on computers is well known." But there is no suggestion in Cohen that his "gift registry" or "bridal registry" is anything more than a displayed table; not the gift registrar application as disclosed by Applicant." (Appellant's Amendment and Response filed 12/20/2006, Page 10, Paragraph 3)

"Independent claims 46 and 47 each contain the same elements from Claim 29 that have been discussed in light of Cohen: element (a) "running a gift registrar application on at least one gift registry site", and element (b) "a gift registrant accessing goods or services online from a goods or service provider (SP) Site" (element (b) in Claim 46 differs from Claim 29 only in that a single Service Provider is claimed rather than a plurality of Service Providers). Neither of these elements is disclosed or even suggested by Cohen as discussed above. While, as a courtesy the above arguments will not be repeated here, Applicant believes that since these elements are not taught by Cohen, nor Shilcrat and since no further support has been given for the Examiner's 'official notice' in the rejections of Claims 46 and 47, the claims are allowable and early favorable action is requested." (Appellant's Amendment and Response filed 12/20/2006, Page 13, Paragraph 2)

Appellant believes that the above language makes the Appellant's timely traversal of the Examiner's taking of "official notice" perfectly plain. Any other interpretation would have to be a blatant attempt to circumvent a procedurally correct examination, which is a duty owed by the PTO to every applicant. If the public already owns the invention, then it should be legitimately so demonstrated, and the claims then rejected. But if it cannot be so demonstrated, then the claims should be allowed. Rejections cannot be made to depend on playing "gotcha" games with the rules of the MPEP as a substitute for the finding of legitimate prior art citations. Why should the Examiner insist on a misinterpretation of the Appellant's traversal of "official notice" and request for proper prior art citation? Surely, it would be simpler to produce the prior art that supports what is so "capable of instant and unquestionable demonstration as being well-

known” than to prompt appeal, petition and perhaps further legal action. Appellant can only assume there are no such references, and that what we have here is a misinterpretation of the language of Appellant’s response shoe-horned into the technicality of a rule. A rule moreover with which Applicant has just demonstrated it was already in compliance.

Appellant also points out that all other claims rejected depend from one of the above claim rejections where the taking of “official notice” was traversed. Claim 31 (Examiner’s Office Action dated 7/20/2006, Page 5), 39 (Page 8), 42 (Page 9), 43 (Page 10), 44 and 45 (Page 10) were rejected with “official notice as applied to claim 29 above”. Claim 33 (Page 6), was rejected with “official notice as applied to claim 32 above”. Claim 34, 35, 36, 37 (Page 6), were rejected with “official notice as applied to claim 33 above” which depended on the official notice given to 32 above. Claims 40 and 41 (Page 9) were rejected with “official notice as applied to claim 39 above” which depended on the official notice given rejecting 29 above. Hence, every claim rejection in fact depends solely upon missing elements of the independent claims being supplied by the imagination of the Examiner under the pseudonym of “official notice”, a misuse which was after all clearly traversed in Appellant’s Amendment and Response filed 12/20/2006.

Examiner admits that he “did not take official notice that it was well known to run a gift registrar application on at least one gift registry site. That was his conclusion based on Cohen and on the general well-known character of applications, as supported by the Microsoft Press Computer Dictionary’s definition of ‘application’ [Emphasis added]” (Examiner’s Answer, Page 19, Paragraph 1). Appellant points out that the Examiner never cited the Microsoft Press Computer Dictionary as grounds for a rejection, although he did include it in the Notice of References Cited that accompanied the final action dated 12/26/06. Appellant finds no support of the “general well know character of applications” in this reference, which reads in its entirety:

“application \[phonetic pronunciation]\ n. A program designed to assist in the performance of a specific task such as word processing, accounting, or inventory management. *Compare* utility.” (Microsoft Press Computer Dictionary)

Appellant certainly does not find such support as would supply the missing claim elements of Appellant’s gift registrar application. There is no reference to 1) a gift registrant accessing a plurality of goods or services provider’s sites, 2) the sites accessed being goods or services

provider's web sites, 3) a gift registrant registering a gift while browsing goods or services provider's sites and 4) a registrant's gift list being stored in a data structure, such as a database. Even as a definition, it is a non-definition; "a computer application is a computer program" is meaningless. Regardless, the reference is meaningless as a support of the rejections, since Appellant is not challenging that computer applications existed in 1999, just that the specific, computer gift registry application with all the limitations claimed did not exist.

Appellant appreciates the assurance that the Examiner believes every fact of which official notice was taken was well known before May of 1999 in spite of the misuse of verb tenses, however "conventional" such misuse may be (Examiner's Answer, Page 19, Paragraph 2). However, it is still clear to Appellant that the Examiner is influenced by the current state of the art and wants the Board to see the current state as the state in 1999. The Examiner repeatedly returns to an argument bootstrapping a general knowledge of applications per se into a supposed general knowledge that the gift registrar application of Appellant's application with all of its limitations existed in 1999. The Cohen article itself communicates that the problem of online gift registry is just beginning to be addressed at the time of its publication. Note that Cohen reports that the American Bridal Registry site requires gift registrants to "supply the site with ordering information" (Cohen, Paragraph 4, Line 21) presumably by entering all the necessary text to create a list display themselves, and for purchasers "to place their orders by phone" (Cohen, Paragraph 4, Line 22), and for purchasers to further "inform the site of their purchases as they make them." (Cohen, Paragraph 4, Line 23) The stone age of e-commerce.

The Appellant thought to provide for the Board a helpful analogy, namely that you cannot claim a jelly donut was well known by claiming that baked goods were well known. (Appeal Brief, Page 11, Paragraph 2) But the Examiner resorts to quibble by saying that "donuts are usually fried rather than baked." (Examiner's Answer, Page 21, Paragraph 1) Applicant is left to wonder if we are not here faced with yet another "official notice;" The Board is respectfully urged to note that it is in just this way that the danger of blithely using "official notice" is brought home. The analogy does hold; that baked goods are well known does not imply that jelly donuts are well known. To establish that 'applications were well known in 1999 or so, is to say absolutely nothing

about the state of the art with respect to a particular kind of application, such as the claimed gift registrar application. A reporting by Cohen that lists of gifts were being published on the Internet does not imply that a particular application was behind those lists, or that such an application was able to use those lists, or able to interact with gift registrants and purchasers.

Finally, at the end of paragraph 2 on page 21 of the Examiner's Answer, the Examiner implies that, since Cohen even so much as addressed the idea of gift registration on the Internet, and since applications were so well known to exist at the time, any application addressing in any way a gift registration would have been obvious. Even if Cohen had clearly identified all the limitations claimed for Appellant's application as features that an online gift registry service should supply its users, and he certainly did not, identifying a problem does not make the solution to that problem obvious. And it certainly does not rob every future inventor of the right to patent their unique mechanism for solving the problem. Otherwise, there would not be more than a hundred issued patents for mouse traps.

In paragraph 3 on page 21 of the Examiner's Answer, the Examiner attempts to refute that Cohen actually teaches away from element (b) of claim 29, by pointing out that Cohen teaches that on one web site couples select items from a list of online retailers. Appellant's claim element reads, "... b) a gift registrant accessing goods or services online from a plurality of goods or service provider sites..." (Claims 29 and 47). Publishing a list of items that are sold somewhere, by some online retailer, is not the same thing as Appellant's claimed method. Appellant's gift registry method is not just posting a list of gift items to one gift registry web site, but a method where gift registrants access a plurality of web sites maintained by actual goods or service providers themselves, and the gift registrant is able to register a gift selection while shopping on those same goods or service provider web sites. Cohen does not teach this element - in fact, his suggestion that a mere list will suffice is exactly what teaches away from the claims on appeal.

Finally, in addressing Appellant's arguments for the remaining dependent claims and independent claims 46 and 47, where in the rejections, the Examiner has combined additional citations or "official notice" to support the rejections of other claim limitations than those discussed above, the Examiner makes much of the fact that Appellant does not (in the Appeal

Brief) "actually address the obviousness of the limitation of claim [claim number] (based upon the [cited reference])" (Examiner's Answer, Page 22 - 25). Appellant does not have to remind the Board that dependent claims necessarily incorporate all the limitations of the independent claims from which they depend, and, therefore contain multiple limitations, not a single new limitation. In traversing an Examiners rejection of dependent claims, it is only necessary to point out a single limitation that is not contained in cited prior art, not all such missing limitations. This applies equally to independent claims where multiple limitations have been challenged by the Examiner; it is only necessary to point out a single limitation that is not contained in cited prior art. We are not obligated to argue, nor is it considerate of the Board's or public's time to argue, every limitation challenged by the Examiner's rejections. While examiners are required to find a prior art citation for each and every element of the claims they reject (usually required that is, unless he relies upon "official notice" to substitute for prior art citation), appellants are not obligated to argue each point. This is, however, a good opportunity to assert that Appellant has in no way conceded the obviousness of any of the limitations upon which the Examiner bases his rejections, and reserves the right to argue them in future, should it become necessary to do so.

Appellant believes he has responded fully to the arguments presented in the Examiner's Answer to Appellant's Appeal Brief. Appellant has demonstrated that the appealed claims contain elements not anticipated by Cohen nor any combination of the cited art, with or without 'official notice'. Appellant has further demonstrated that these same elements are not well known facts capable of instant and unquestionable demonstration as required by case law and the rules of the MPEP. Therefore, Appellant requests that all of the Examiner's rejections be reversed by the Board, and the claims ordered allowed.

For the Board's convenience, the claims on appeal are again set forth in the attached Appendix.

Respectfully submitted,



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CLAIMS APPENDIX

Claims on Appeal:

1. - 28. (Cancelled)

29. A method of providing a gift registry service over a distributed network of computers, the method comprising the following steps:

- a. running a gift registrar application on at least one gift registry site;
- b. a gift registrant accessing goods or services online from a plurality of goods or service provider (SP) sites, and registering a gift selection from each of the plurality of SP sites into a gift registrant wish list;
- c. the gift registrar application storing the wish list into a wish list data memory structure accessible to at least one gift registry site; and
- d. a gift purchaser accessing the stored wish list from a site on the distributed network remote from any gift registry site.

30. The method of Claim 29 further comprising, in step d, the gift purchaser accessing the wish list by searching for at least one criterion.

31. The method of Claim 29 further comprising the following steps, where step e occurs at any time after step b; and the timing and sequence of steps e - g are not dependent on steps c - d:

- e. the gift registrant creating a distribution list, the distribution list being stored in a distribution list data memory structure accessible from the gift registry site;
- f. the gift registrant requesting that the gift registrar application send notifications to members of the distribution list; and
- g. the gift registrar application sending notifications to members of the distribution list.

32. The method of Claim 29 further comprising, at any time after step b, the gift registrant registering an occasion and associating at least one wish list with the occasion, the occasion data and the association(s) being stored in an occasion data memory structure accessible to the gift registry site.

33. The method of Claim 32 further comprising, after the step of registering an occasion, the gift registrant creating a distribution list, the distribution list being stored in a distribution list data memory structure accessible to the gift registry site; and further associating the distribution list with an occasion and the association being stored in a data memory structure accessible to the gift registry site.

34. The method of Claim 33 further comprising, after the steps of associating the occasion with a distribution list and storing the association, the gift registrant specifying an occasion reminder for repeating notifications, the occasion reminder being stored in an occasion reminder data memory structure accessible to the gift registry site.

35. The method of Claim 34 further comprising, after the step of specifying the occasion reminder, associating a wish list to the occasion reminder, and storing the association in an occasion reminder data memory structure accessible to the gift registry site.

36. The method of Claim 34 further comprising, after the step of specifying the occasion reminder, associating an SP site link to the occasion reminder, and storing the association in an occasion reminder data memory structure accessible to the gift registry site.

37. The method of Claim 34 further comprising, after the step of specifying the occasion reminder, the gift registrant specifying at least one occasion trigger for notification of the members of the associated distribution list; and further the gift registrar application automatically sending the occasion reminder to each of the members of the distribution list upon the tripping of an occasion trigger.

38. The method of Claim 37 further comprising, after the step of automatically sending the occasion reminder to the members of the associated distribution list, the gift registrar application automatically sending an occasion notification to at least one SP upon the tripping of an occasion trigger.

39. The method of Claim 29 further comprising, at any time before, during or after steps a - d:

h. an SP registering a sale event by sending sale event data over the network of computers to the gift registry site; and

i. the gift registry site storing the sale event data in a sale event data memory structure accessible to the gift registry site.

40. The method of Claim 39 further comprising, after step i, at least one of the following steps:

j. the gift registrar application displaying the sale event data to users accessing the gift registry site; and

k. the gift registrar application sending a sale event notification.

41. The method of Claim 40 wherein in step k, the sale event notification contains pertinent wish list data.

42. The method of Claim 29 further comprising, after step d, the gift purchaser viewing a display of multiple SP's from whom the purchaser may purchase items on the gift registrant's wish list.

43. The method of Claim 29 further comprising, after step d, the gift registrar application indicating the most desirable SP for an item on the gift registrant's wish list.

44. The method of Claim 29 further comprising, after step d, the following steps:

l. the gift purchaser purchasing a gift suggested by the gift registrant's wish list; and

m. the gift registrar application storing data pertaining to the gift purchaser's purchases for a gift registrant in a purchased items data memory structure accessible to the gift registry site.

45. The method of Claim 44 wherein, after step m, the gift registrar application provides gift recommendations to prospective gift purchasers, based upon gifts previously purchased for the gift registrant whose wish list the purchaser is accessing.

46. A method of providing a gift registry service over a distributed network of computers, the method comprising the following steps:

a. running a gift registrar application on at least one gift registry site;

b. a gift registrant accessing goods or services online from a goods or service provider (SP) site, and registering a gift selection from the goods or service provider site into a gift registrant wish list;

c. the gift registrar application storing the wish list into a wish list data memory structure accessible to at least one gift registry site; and

d. a gift purchaser accessing the stored wish list from a site on the distributed network remote from any gift registry site.

47. A method of providing a gift registry service over a distributed network of computers, the method comprising the following steps:

- a. running a gift registrar application on at least one gift registry site;
- b. a gift registrant accessing goods or services online from a plurality of goods or service provider (SP) sites, and registering a gift selection from each of the plurality of SP sites into a gift registrant wish list;
- c. the gift registrar application storing the wish list into a wish list data memory structure accessible to at least one gift registry site;
- d. a gift purchaser accessing the stored wish list from a site on the distributed network remote from any gift registry site; and
- e. the gift registrar application indicating to the gift purchaser the most desirable SP for at least one item on the gift registrant's wish list.